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| 10/747,678 | 12/30/2003 | Roy Ben-Yoseph | 06975-540001 / Security 3 | 2895 |

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| EXAMINER |
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| TAHA, SHAQ |

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| 2146 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/747,678 | BEN-YOSEPH, ROY |
| **Office Action Summary** | Examiner | Art Unit |
| | SHAQ TAHA | 2146 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>12/21/2007</u>.
2a)☒ This action is **FINAL**.      2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☐ Claim(s) _____ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1 - 39</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>101/04/2008, 2/22/2008</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

## DETAILED ACTION

## *Response to Arguments*

Applicant's arguments with respect to claims1-39 have been considered but are moot in

view of the new ground(s) of rejection.

## *Claim Objections*

Claim 29 is objected to because of the following informalities:  claim 29 depends on

canceled claim 24.  Appropriate correction is required.

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains.  Patentability shall not be negatived by the manner in which the invention
> was made.

-        Claims 1 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable

         over Malik et al. (US 7,133,898), and further in view of Sheldon et al. (US

         6,708,205).

Regarding claim 1, 20, and 39 Malik teaches a method of displaying e-mail: **[Fig. 8, Ref # 810];** maintaining a list of identities associated with a user, **[Prior to presenting the e-mails to the user, the client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract) & (Fig. 4)];**

Malik differs from the claimed invention is that determining that an entity is associated with the user based on positive user actions related to e-mail communications with the entity.

Sheldon et al. teaches a method for providing e-mail communication is provided in which an e-mail user interface is generated on a display device.

Sheldon et al. further teaches determining that an entity is associated with the user based at least in part, on the positive user actions related to e-mail communications with the entity, **[Only those contacts who have not been blocked are displayed, wherein the contact who have not been blocked have a positive actions with the user, (Column 18, line 34)];**

Sheldon et al. further teaches adding the entity to the maintained list when the entity is determined to be associated with the user based, at least in part, on the positive actions related to the e-mail communications with the entity, **[Upon selecting the add button, a contact list window is displayed that containing all the senders in the Address Book, (Column 18, line 31)];**

Malik further teaches receiving one or more e-mails directed to the user, **[E-mail is received at the e-mail server and periodically downloaded upon request from the e-mail client, (Column 1, lines 55 – 60) & (Fig. 8, Ref # 810)]**;

identifying senders of the received e-mail, **[The vendor registration code is a string of characters used to identify e-mail from the particular e-mail source, (Column 6, lines 45 – 50) & (Fig. 6, Ref # 814)]**;

comparing the identified senders to the maintained list of people associated with the user to determine which of the senders are included on the list, **[Fig. 7, Ref # 714, it is determined whether the username and source identify a contact of the particular user]**;

displaying a list of the e-mail to the user, **[Fig. 8, Ref # 810]**;

sorting the displayed list based on which of the senders are included in the list, **[Fig. 8, Ref # 812 & 814]**.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Malik by including that determining that an entity is associated with the user based at least in part, on the positive user actions related to e-mail communications with the entity as taught by Sheldon.

One of ordinary skill in the art would have been motivated to make this modification in order provide the advantage of adding the entity to the maintained list when the entity is determined to be associated with the user based, at least in part, on the positive actions related to the e-mail communications with the entity.

Regarding claim 2& 21, Malik teaches the method wherein sorting the display based on

which of the senders are included in the list comprises sorting the display such that e-

mails from identities on the list are grouped in one position of the display, **[Fig. 8, Ref #**

**812 & 814].**


Regarding claim 3 & 22, Malik teaches the method wherein sorting the display, based

on which of the senders are included in the list comprises sorting the display such that

e-mails from identities on the list are displayed and e-mails from identities not on the list

are not displayed, **[Fig. 8, Ref # 812 & 814].**


Regarding claim 4 & 23, Malik teaches the method wherein sorting the display based on

which of the senders are included in the list comprises sorting the display such that e-

mails from identities on the list are not displayed and e-mails from identities on the list

are not displayed, **[Fig. 8, Ref # 812 & 814].**


Regarding claim 6 & 25, Malik teaches the method wherein the positive actions include

sending an e-mail to the entity, **[someone that that the user knows, whether the e-**

**mail is from a commercial vendor that has registered to send e-mail to the user,**

**[(Column 1, lines 62 – 67)].**


Regarding claim 7 & 26, Malik teaches the method wherein the positive actions include

replying to, forwarding, saving, or printing an e-mail received from the entity, **[e-mail**

**users spend significant amounts of time reviewing and replying to the numerous**

**e-mails that they receive daily, [(Column 1, lines 30 – 32) & (Column 2, line 2)].**

Regarding claim 8 & 27, Malik teaches the method wherein the positive actions include

moving an e-mail from a first folder to a second folder, **[Fig. 8, Ref # 810 & 812].**

Regarding claim 9 & 28, Malik teaches the method wherein the first folder is an inbox

folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig.**

**8, Ref # 810 & 812].**

Regarding claim 10 & 29, Malik teaches the method wherein the positive action includes

leaving an e-mail from the entity open for a predetermined period of time, **[Fig. 8, Ref #**

**810, 812, 814].**

Regarding claim 11 & 30, Malik teaches that the method further comprising: inferring

that a person is associated with the user based, at least in part, on detecting a

communication between the user and the person, **[Prior to presenting the e-mails to**

**the user, the client sorts the e-mail into classifications based upon whether the e-**

**mail is from a personal contact, (Abstract)];**

adding the inferred person to the list, **[storing a vendor registration code for the e-**

**mail source; storing a vendor registration purpose code for the e-mail source,**

**(Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].**

Regarding claim 13 & 32, Malik teaches that the method further comprising inferring that

a person is associated with the user and adding the person to the maintained list,

wherein inferring comprises: accessing a contact list of the user to determine a first

contact on the user's contact list, **[Fig. 7, Ref # 714];**

**and accessing a contact list of the first contact to determine a second contact on**

**the first contact's contact list, [Fig. 7, Ref # 714].**

Regarding claim 14 & 33, Malik teaches that the method further comprising determining

that a person is associated with the user based, at least in part, on detecting user

actions that negate an inference that a person is associated with the user, **[Prior to**

**presenting the e-mails to the user, the client sorts the e-mail into classifications**

**based upon whether the e-mail is from a personal contact, (Abstract)].**

Regarding claim 15 & 34, Malik teaches the method wherein the user actions comprise

reporting a communication from the person as spam, **[E-mail users must sort through**

**all of the SPAM in order to get to the e-mail that they desire to see, (Column 1,**

**lines 34 – 36)].**

Regarding claim 16 & 35, Malik teaches the method wherein the user actions comprise

adding a person to a blacklist, **[Fig. 8, Ref # 814].**

Regarding claim 17 & 36, Malik teaches the method wherein the user actions comprise

moving a communication from the person to either of a spam folder or a delete folder,

**[Fig. 8, Ref # 812 & 814].**


Regarding claim 18 & 37, Malik teaches that the method further comprising: enabling

the user to expressly designate a person as associated with the user, **[Fig. 7, Ref # 724**

**& 732];** and adding the designated person to the list, **[storing vendor registration**

**code for the e-mail source; storing a vendor registration purpose code for the e-**

**mail source, [(Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].**


Regarding claim 19 & 38, Malik teaches the method wherein the people associated with

the user are people known to the user, **[The client sorts the e-mail into**

**classifications based upon whether the e-mail is from a personal contact,**

**(Abstract)].**


- Claims 12 & 31 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Malik et al.  in view of  Sheldon et al. and further in view

of Lewis et al. (US 2003/0110212).


Regarding Claims 12 & 31, Malik teaches a system for intelligently sorting e-mail

comprises a client, which downloads e-mails from a server, **(See Abstract).**

Sheldon et al. teaches a method for providing e-mail communication is provided in which an e-mail user interface is generated on a display device.

Sheldon et al. differs from the claimed invention is that the communications are instant messages is not taught in Sheldon et al.

Malik et al. differs from the claimed invention is that the communications are instant messages is not taught in Malik et al.

Lewis teaches a method for providing message information to a subscriber in a wireless network includes reading a cookie from a browser, modifying the cookie with the message information, transmitting the modified cookie to the browser, and displaying data to the subscriber based on the message information contained in the cookie, **(See Abstract)**, and further teaches that **[text messages including, for example, short messages, instant messages, and MOBITEX messages, enhanced messages, (Paragraph 0212)]**.

Lewis provides the advantage of that the communications are instant messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Malik and Sheldon by including that the communications are instant messages as taught by Lewis.

One of ordinary skill in the art would have been motivated to make this modification in order to provide the advantage of that the communications are instant messages.

## *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shaq Taha whose telephone number is 571-270-1921.

The examiner can normally be reached on 8:30am-5pm Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeff Pwu can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

03/13/08

S. Taha

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146